

REMARKS/ARGUMENTS

Claims 1-5, 7-9 and 11-26 are pending, claims 12-14 and 18-22 having been withdrawn from consideration. By this Amendment, claims 6 and 10 are cancelled, and claims 1 and 11 are amended. Support for the amendments to claims 1 and 11 can be found, for example, in original claims 1, 6, 10 and 11. No new matter is added. In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

Withdrawn Claims

For the reasons set forth below, Applicants submit that all pending claims presently subject to examination are in condition for allowance. Because at least withdrawn claims 12-14 depend from, and thus recite all features of, allowable claims presently subject to examination, rejoinder and allowance of the withdrawn claims are respectfully requested.

Rejection Under 35 U.S.C. §112, First Paragraph

The Office Action rejects claims 1-11, 15-17 and 23-26 under the enablement requirement of 35 U.S.C. §112, first paragraph. By this Amendment, claims 6 and 10 are cancelled, rendering the rejection moot as to those claims. As to the remaining claims, Applicants respectfully traverse the rejection.

The Office Action asserts that claims 1-11, 15-17 and 23-26 are not enabled by the present specification. *See* Office Action, page 2. In particular, the Office Action asserts that the present specification enables only the particular embodiments described in the Examples of the present specification. *See* Office Action, page 2. Applicants respectfully disagree.

As is well-settled, compliance with the enablement requirement does not turn on whether an example is disclosed. *See, e.g.*, MPEP §2164.02. In view of this settled principle,

the Office Action's assertion that only the embodiments of the Examples of the present specification are enabled is inappropriate. Claim 1 clearly defines an active principle, a synthetic polymer, and respective amounts of those components. The present specification describes specific compounds/compositions falling within the generic descriptions recited in claim 1. *See, e.g.*, present specification, page 12, line 27 to page 13, line 4. The Examples of the present specification describe exemplary methods of manufacturing particles (*see, e.g.*, present specification, page 14, lines 4 to 21) and exemplary methods of testing the efficacy (e.g., leaching) of the manufactured particles (*see, e.g.*, present specification, page 14, line 23 to page 15, line 13). It would be well within the ability of one of ordinary skill in the art to, for example, perform the manufacturing and evaluation methods of the Examples of the present specification with compounds/compositions other than those explicitly identified in the Examples. Such experimentation can hardly be considered "undue." *See, e.g.*, MPEP §2161.01(a) (citing *In re Angstadt*, 190 USPQ 214, 219 (CCPA 1976)) (stating that test of enablement is not whether any experimentation is necessary, but whether experimentation is undue).

The Office Action appears to object to the present specification's alleged failure to disclose the scientific principles underlying the effectiveness of the disclosed particles. *See* Office Action, pages 5 to 6. Applicants need not include such disclosure, so long as the provided disclosure is sufficient to permit a skilled artisan to make and use the claimed invention. *See* MPEP §2164.01.

For the foregoing reasons, claims 1-5, 7-9, 11, 15-17 and 23-26 are fully enabled by the specification as filed. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection Under 35 U.S.C. §102

The Office Action rejects claims 1-9, 15, 16 and 23-26 under 35 U.S.C. §102(b) over U.S. Patent No. 5,242,689 to Yoshihara et al. ("Yoshihara"). By this Amendment, claim 6 is cancelled, rendering the rejection moot as to that claim. As to the remaining claims, Applicants respectfully traverse the rejection.

Claim 1 recites "[p]articles comprising: at least one active principle comprising one or more aromatic, carbocyclic or heterocyclic, monocyclic or fused polycyclic groups, with a molecular weight of less than or equal to 1000; and at least one synthetic polymer comprising aryl groups, with a glass transition temperature (T_g) of greater than or equal to 45°C; wherein: a weight ratio of the at least one active principle to the at least one synthetic polymer is from 1/1 to 1/50; and the at least one synthetic polymer is a polyorganosiloxane comprising aryl groups linked directly to silicon atoms of the siloxane skeleton" (emphasis added). Yoshihara does not disclose or suggest such particles.

Applicants note that claim 1 has been amended to incorporate the subject matter of claim 10, which is not subject to the rejection over Yoshihara. Accordingly, amended claim 1 is believed to be patentable over Yoshihara.

Yoshihara discloses a particle including a solid core of organic or inorganic substances and a coating of a pyrrole copolymer. *See* Yoshihara, column 2, lines 37 to 60. Exemplary organic or inorganic substances in Yoshihara include titania (*see* Yoshihara, column 3, line 68 (Synthesis Example 1)) and styrene/stearyl methacrylate/divinylbenzene copolymer (*see* Yoshihara, column 4, lines 12 to 13 (Synthesis Example 2)). Nowhere does Yoshihara disclose that the recited particles could or should include a polyorganosiloxane comprising aryl groups.

As Yoshihara fails to disclose or suggest particles including a polyorganosiloxane comprising aryl groups, Yoshihara fails to disclose or suggest each and every feature of claim 1.

As explained, claim 1 is not anticipated by Yoshihara. Claims 2-5, 7-9, 15, 16 and 23-26 depend from claim 1 and, thus, also are not anticipated by Yoshihara. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Conclusion

For the foregoing reasons, Applicants submit that claims 1-5, 7-9 and 11-26 are in condition for allowance. Prompt reconsideration and allowance are respectfully requested.

Respectfully submitted,

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